

REMARKS

Applicants thank the Examiner for the careful examination of the application. Reconsideration and allowance of the application, as amended, is respectfully requested. Claims 1-15 are now pending in the application. Claim 9 has been amended to clarify that the “web pages” are accessible through “a web browser.” Claim 10 has been amended for clarification purposes to denote “a computer system” rather than “said computer system.” Finally, Claim 14 has been amended to indicate that the system parses web pages in order to identify telephone numbers by using a predictive or adaptive algorithm. Applicants submit that no new matter is contained in these amendments.

I. CLAIM REJECTIONS UNDER 35 U.S.C. §112

The Examiner has rejected Claims 10-13 for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 9 has been amended to state “parsing through web pages on a web browser” and therefore provides proper antecedent basis for “said web browser” in claims 10-13. Claim 10 has also been amended such that “said computer system” now reads “a computer system.” Applicants respectfully submit that no new matter is contained in these amendments and respectfully requests that the Examiner withdraw the §112 rejections.

II. CLAIM REJECTIONS UNDER 35 USC § 103

According to the Examiner, claims 1-15 are unpatentable as obvious under 35 U.S.C. §103(a). §103 states as follows:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

An obviousness rejection can be based on combining a single primary reference with one or more other secondary references in order to meet the rejected claim. However, even though prior art references may be combined to establish obviousness, it is well settled that it is the burden of the Examiner to establish a *prima facie* case of obviousness when rejecting claims. *In re Reuter*, 651 F.2d 751, 210 U.S.P.Q. 249 (CCPA 1981); MPEP §2142. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974); MPEP §2143.03.

In *Graham v. John Deere Co.*, 383 U.S. 1 (1966), the U.S. Supreme Court held that in applying the “nonobvious condition on patentability ... the Patent and Trademark Office should make ‘several basic factual inquiries.’ The inquiries are: (1) ‘the scope and content of the prior art,’ (2) ‘differences between the prior art and the claims at issue,’ and (3) ‘the level of ordinary skill in the pertinent art.’” *Chisum on Patents*, §5.03. This factual inquiry was recently reaffirmed by the Court as being the “framework for objective analysis for determining obviousness” in the all-important case of *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 U.S.P.Q.2d 1385 (2007); MPEP §2141. “Once the *Graham* factual inquiries are resolved, Office personnel must determine whether the claimed invention would have been obvious to one of ordinary skill in the art.” *Id.* Furthermore, the Examiner “should consider all rebuttal evidence that is timely presented by the Applicants when reevaluating any obviousness determination.” MPEP §2141. For example, the Examiner must take into consideration rebuttal evidence of secondary considerations, such as long felt but unsolved needs, failure of others, and unexpected results, whereby the evidence is presented in a timely manner during prosecution. *Graham*, 383 U.S. at 17; MPEP §2141.

Applicants respectfully submit that the Examiner has not met the burden of establishing a *prima facie* case of obviousness.

A. Kim in view of Strathmeyer et. al. Does Not Teach Every Claim Limitation of Claim 1

The Examiner asserts that Claims 1-3, 6, and 8 are unpatentable as obvious over U.S. Pat. No. 7,177,415 to Kim (*Kim*), in view of U.S. Pat. No. 6,876,633 to Strathmeyer (*Strathmeyer*). With respect to claim 1, the Examiner contends that *Kim* discloses a method for identifying a telephone number to a computer system for processing a telephone call over the Internet to a user assigned to said telephone number comprising: receiving data entered into said computer system by a caller through a web browser; searching said data for said telephone number or a proxy representing said telephone number; processing said telephone call through a packet switched data network to said telephone number if said telephone number is found in said data.

The Examiner concedes that *Kim* doesn't specifically disclose accessing a name server to translate the proxy into a telephone number for return to the computer system for processing the telephone call if a telephone number is not found in the data. However, the Examiner believes that *Strathmeyer* discloses the accessing step. Based on the following, Applicants respectfully submit that the Examiner's §103 rejection was in error and respectfully requests withdrawal of same.

As previously argued, Applicants respectfully submit that the Examiner has failed to show that *Kim* discloses processing a telephone call over a packet switched data network (e.g., the Internet); rather *Kim* describes processing a telephone call over a telephone line. *Kim* describes obtaining a phone number from the Internet and automatically or manually dialing the telephone line for the number.

The telephone plug-in 230 connects to the telephone 240 with the selected telephone number using the same telephone line 260 (first telephone line) as that used to connect the information terminal with web browser 200 to the web server 210. That is, **the information terminal with the web browser 200 is not connected to the web server 210 while the telephone plug-in 230 is in use.** Thus, **the internet connection between the information terminal with the web browser 200 and the web server 210 is disconnected while the telephone plug-in 230 operates and dials a corresponding telephone number automatically and connects the telephone with the selected telephone number (step 380).**

Kim, Col. 4, lines 21-33 (emphasis added). *Kim* clearly notes that the Internet connection is disconnected while the telephone plug-in operates and dials a phone number.

Accordingly, *Kim* cannot process the call over a packet switched data network when the data connection is disconnected while the telephone number is dialed. Further, a rigorous review of *Kim* establishes that the reference does not describe using the Internet to process or actually carry the call:

Here, the telephone plug –in 230 is an apparatus or software for automatically connecting a telephone according to the searched for telephone number. In other words, an automatic dialing operation carries out a program, i.e., a dialing routine, which receives the telephone number from the web browser 200 and automatically dials the number.

Kim, Col. 4, lines 14-20 (emphasis added). When available, *Kim* uses an automatic dialing program that dials the telephone number found in the Internet search on the telephone line. The <dialto> function only works where such a link is expressed by <dialto>. When the link selected by the user is not defined by <dialto,> the user has to make a phone call manually. See *Kim*, Col. 4, lines 53-55. Accordingly, the dialing program of *Kim* does not use a packet switched data network (i.e. the Internet) to process or carry the claimed telephone call.

Processing and carrying calls over the Internet, or other similar packet switched data network, is a required element of independent Claims 1, 9 and 14, as all claims are directed to telephone calls being made over the Internet. Accordingly, *Kim* does not teach a critical limitation of Claim 1 and therefore *Kim* cannot render Claim 1 obvious, even in combination with another reference. Indeed, *Strathmeyer* does not make up for the deficiencies in *Kim*. Consequently, because *Kim* does not teach or disclose executing telephone calls over a packet switched data network it cannot, even in combination with *Strathmeyer*, meet the limitations of Claims 9 and 14.

B. *Kim* in view of of *Strathmeyer* further in view of *Kincaid* Does Not Teach Every Claim Limitation of Claims 4 or 5

The Examiner has rejected dependent claims 4 and 5 as obvious in light of *Kim* in view of *Strathmeyer* and further in view of U.S. Pat. App. Pub. No. 2002/0169764 to Kincaid (*Kincaid*). With respect to claim 4, the Examiner contends that *Kincaid* teaches a

method wherein a web browser creates search hook objects to translate data when the web browser is unable to identify the established call protocol. With respect to claim 5, the Examiner contends that *Kincaid* also teaches a method wherein data that cannot be translated using search hook objects is transferred back to the web browser (*See* ¶ 0089).

Applicants respectfully traverse the Examiner's position with respect to claims 4 and 5 because *Kincaid* does not describe the use of "hook objects" in the manner required in the present invention. The "hooks" in *Kincaid* monitor what documents a user opens and the amount of time that a user spends looking at a particular document:

The "hooks" are supplied by embedding an Internet Explorer frame within the application to be used as a "preview frame 38. Internet Explorer exposes interfaces that can be called to provide notification whenever the **user performs certain actions**, to include opening a particular page for viewing. By such notification, the present invention can track how long a page is being displayed in the preview frame 38, **as well as how much the user interacts with it.**

Kincaid ¶ 89 (emphasis added). However, in the present invention, search hook objects are created from call data rather than user behavior. Accordingly, the "hooks" in *Kincaid* are not analogous to and therefore do not meet the claimed "hook objects" in the present invention. Moreover, nowhere in *Kincaid* is it stated that hook data is transferred back to the web browser when data cannot be translated as required by Claim 5. Therefore, claims 4 and 5 are not rendered obvious by the combination of *Kim*, *Strathmeyer*, and *Kincaid*.

C. *Kim* in view of *Stanford* Does Not Teach Every Claim Limitation of Claim 9 or Amended Claim 14

The Examiner asserts that Claims 9-15 are unpatentable as obvious over *Kim* in view of U.S. Pat. App. Pub. No. 2007/0189500 to Stanford (*Stanford*). With respect to claim 9, the Examiner contends that *Kim* discloses a method of parsing through web pages to identify a telephone number or a proxy comprising the steps of: using a specified predictive or adaptive algorithm to detect telephone number data. The Examiner concedes that *Kim* doesn't specifically disclose transforming each identified

telephone number that is detected into a URI or providing a user with the transformed telephone number as a URI. However, the Examiner believes that *Stanford* discloses these steps.

With respect to claim 14, the Examiner contends that *Kim* discloses a system that allows users to place and receive calls using a web browser, said system comprising: a computer connected to a computer network; said computer equipped with a web browser; and said web browser with the ability to parse web pages and identify a telephone number. The Examiner concedes that *Kim* doesn't specifically disclose a system wherein said web browser is enable to convert a detected telephone number into a URI and provide the URI as a hyperlink; said computer enable to obtain and display the URI provided by the web browser and said web browser enable to connected a user of the system with the telephone number associated with URI by dialing the telephone number associated with the URI. However, the Examiner believes that *Stanford* discloses these elements.

Applicants respectfully traverse the Examiner's rejection of Claims 9 and 14. *Kim* does not disclose a method of parsing through web pages to identify a telephone number. Claim 9 and Amended Claim 14 are directed to a method and system of parsing through web pages to identify a telephone number or a proxy comprising the steps of: using a specified predictive or adaptive algorithm to detect telephone number data; transforming each identified telephone number that is detected into a URI; and providing a user with the transformed telephone number as a URI. The sections of *Kim* identified by the Examiner, Col. 3, lines 9-24 and Col. 3, lines 48-69, describe searching for a phone number in a telephone directory database, displaying the search results as an HTML document and automatically or manually dialing the telephone number on a telephone line:

The flowchart shown in FIG.3 includes the steps of connecting to the telephone web server using the web browser (step 300), inputting the name of a person or company to be searched in the home page of the web server (step 310), **searching for the name of the person or company input to the web server from the telephone directory database** and transferring the results of the search as an HTML document (step 320), displaying the HTML document (step 330), selecting a link the user desires from the displayed HTML document

(step 340), determining whether the link selected by the user is described by "dialto" (step 350), operating a telephone plug-in if the link selected by the user is "dialto" (step 360), making a telephone call manually if the link selected by the user is not "dialto" (step 370), and automatically making a phone call (step 380) if the telephone plug-in is operated in step 360.

The user inputs the name of the person to or company to be **searched for in the telephone directory database 220** and the address or the keyword thereof, and clicks a search button (step 310)...

When the information to be searched for is input to the home page of the web server 210 and the search button is clicked, the **web server 210 searches for the telephone numbers stored in the telephone number database 220** of all the John Does living in Washington D.C., and transfers the searched results as an HTML document (step 320).

Kim, Col. 3, lines 9-24, 48-51, and 54-59 (emphasis added). Accordingly, *Kim* does not disclose a specified predictive or adaptive algorithm to detect a phone number, as required by both Claim 9 and Amended Claim 14. Rather, *Kim* describes cross referencing the name of a person or company with a telephone directory database to pull a telephone number and then displaying the number as an HTML document; there is no implementation of an algorithm to detect telephone number data from web pages on a web browser. Moreover, *Kim* does not use the Internet to place the call, rather uses a land-based line to place the call. Further, *Stanford* does not make up for the deficiencies in *Kim* as it does not teach the required predictive or adaptive algorithm to detect telephone number data as required in the claims. Consequently, because *Kim* does not teach or disclose the use of a specified predictive or adaptive algorithm it cannot, even in combination with *Stanford*, meet the limitations of Claims 9 and 14.

D. Claims 1-15 are Not Obvious

For the reasons noted above, *Kim* in view of *Strathmeyer* does not disclose every element of the independent Claim 1 and *Kim* in view of *Stanford* does not disclose every element of independent claims 9 and 14. Therefore, Claims 1, 9, and 14 are not unpatentable under 35 U.S.C. §103. Similarly, dependent claims 2-8, 10-13 and 15 are not unpatentable by *Kim* and either *Strathmeyer* or *Stanford* under 35 U.S.C. §103 for

failure to disclose each and every element of the challenged claims, as a dependent claim shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim. M.P.E.P. §608.01(n). Accordingly, Applicants respectfully request that the rejection under 35 U.S.C. § 103 be withdrawn as to all of Claims 1-15.

III. CONCLUSION

Applicants submit that this Amendment and Response, if entered, places Claims 1-15 in a condition for allowance and respectfully requests that such action be taken by the Examiner at this time.

Should a telephone conference be deemed helpful to assist the Examiner's evaluation of this application, a telephone call to the undersigned at (305) 448-7089 is respectfully solicited.

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